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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,230	08/30/2001	John Whitman	4294.1US (98-1208.1)	2488
24247	7590	01/27/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			DICKEY, THOMAS L	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/944,230	<b>Applicant(s)</b> WHITMAN ET AL.	
	<b>Examiner</b> Thomas L Dickey	<b>Art Unit</b> 2826	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 14.

Claim(s) rejected: 1,3,4,11-13 and 15-24.

Claim(s) withdrawn from consideration: 2 and 5-10.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Minhloan Tran*  
**Minhloan Tran**  
**Primary Examiner**  
**Art Unit 2826**

Art Unit: 1-8-2-6

## Continuation of 5:

The information disclosure statement filed 01/03/2005 fails to comply with 37 CFR 1.97(d) because it lacks the fee set forth in 37 CFR 1.17(p), and, further, because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. Applicant is urged to re-read Rule 1.97(e). The rule requires either a specific statement of facts directed to activity in an overseas patent office (1.97(e)(1)), or, to briefly paraphrase, a specific statement of facts directed towards what applicant knew and when applicant knew it (1.97(e)(2)).

It is argued at page 2 of the remarks that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 1 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." To this the Examiner replies "That which infringes if later anticipates if earlier." *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889). The Supreme Court has never reversed itself on this point. Furthermore, the Federal Circuit has relied on this axiom to resolve three of the hardest questions of fact it has faced in the past decade. See *In re Schreiber*, 44 USPQ2d 1429, 1434 (Fed. Cir 1997); *SmithKline Beecham Corp. v. Apotex Corp.*, 70 USPQ2d 1737, 1744 (Fed. Cir 2004); and *Schering Corp. v. Geneva Pharmaceuticals Inc.*, 67 USPQ2d 1664, 1669 (Fed. Cir 2003).

The question, simply put, is whether a device which *infringed* Applicants' claims to, inter alia, a "material layer having a surface substantially free of hills and valleys," would have such a surface adequately described by a sectional drawing representing said surface as a straight, flat, horizontal line. The Examiner finds that it would. For this reason, the Examiner finds that the disclosure of Yates et al. 6,358,793, which includes such a sectional drawing, adequately described a device which anticipated Applicants' claims.

It is argued at page 2 of the remarks that, "At page 7 of the Final Office Action, the Examiner incorrectly infers that, in order to for a claim to be allowable, the advantages of the subject matter recited therein must be clear." However, what the Examiner actually wrote on page 7 was, "[T]he examiner takes the position that the surface disclosed by Yates, while perhaps lacking in perfect planarity, are nonetheless substantially planar. Why is applicant so insistent in pointing alleged deficiencies in the prior art when he has not yet described the advantages of his own invention?" The point was, Applicants' repeated insistence that the disclosure of Yates et al. is deficient in disclosing a surface that is flat and smooth on some specific small-scale level is simply not helpful in resolving the question of whether Yates et al. adequately discloses a (claim language quote) "material layer having a surface substantially free of hills and valleys."

It is argued at page 4 of the remarks that, "Yates has been relied upon for its depiction of the surface of a photoresist with straight lines." This is a factual misstatement Yates et al. is relied upon solely for its disclosure of "a material layer disposed over a substrate and substantially filling at least one recess," wherein, for certain dependent claims, said material layer is a "mask material." The claims do not require "a photoresist with straight lines." Yates et al. is not relied upon for anything not required of the claims.

It is further argued at page 4 of the remarks that, "[O]ne or ordinary skill in the art would have expected the surface of a prior photoresist layer, particularly a photoresist layer which overlies a nonplanar substrate surface, to have a variety of miniscule nonplanar features, including hills and valleys of different elevations and dimensions, angled surfaces between the hills and valleys, and the like. As those of ordinary skill in the art have recognized, such surfaces have primarily been illustrated as planar for the sake of simplicity (see, e.g., Wang '001 and Yoshihara)." This may or may not be true, but it is certainly moot. Yates et al. is not relied upon for a photoresist layer that lacks a variety of miniscule nonplanar features, whether said miniscule features are hills, valleys, or angled surfaces between hills and valleys. Yates et al. discloses a material layer (which may be a mask layer) having a surface substantially free of hills and valleys. The photoresist question is a moot question.

It is argued, at page 7 of the remarks, that "Again, independent claims 1 and 15 require a material layer with a surface that is "substantially free of hills and valleys." As Wang teaches that the upper smoothening surface 62 of the smoothening layer 60 thereof may include slight depressions" (i.e., valleys), Wang does not anticipate this element of either independent claim 1 or independent claim 15." This repeats, word for

Art Unit: 2816

word, the argument Applicants made on page 8 of their 9/20/04 paper. The Examiner responds, exactly as he did on 11/03/04, that applicant's limitation, common to claims 1 and 15, of *a material layer disposed over a substrate and substantially filling at least one recess, having a surface substantially free of hills and valleys*, is met by Wang, first of all because Wang, although having a slight depression, has nothing that may be described as a "hill," and thus is free of the claimed combination of "hills and valleys;" secondly because the slight depressions found in Wang nonetheless leave Wang substantially free, even of valleys.